

REMARKS

The claims remaining in the present application are Claims 1-28. The Examiner is thanked for performing a thorough search. Claims 1-13, 15, 18-20, 21-23, 25, 27 and 28 have been amended. No new matter has been added due to the amendments to the claims. The specification has been amended to add a new paragraph. No new matter has been added due to adding this paragraph. For example, support for this new paragraph can be found in Claim 19.

SPECIFICATION OBJECTION

In paragraph 5, the Office Action states, "It appears that the specification fails to provide antecedent basis for the claim terminology 'computer-usable medium' recites in claims 19-28." Applicants traverse this objection. For example, the last paragraph of the instant application serial no. 10/635,594 states, "The foregoing descriptions of specific embodiments of the present invention have been presented for purposes of illustration and description.... It is intended that the scope of the invention be defined by the Claims appended hereto and their equivalents." Claim 19 uses the term "computer-usable medium" which is a well known term in the art. Claim 19 clearly states that the "computer-usable medium" has "computer-readable code embodied therein for causing a computer system to perform ..." Therefore, the instant application clearly provides enough information for one of ordinary skill in the art to make or use a computer-readable medium that has "computer-readable code embodied therein for causing a computer system to perform..."

CLAIMS REJECTIONS

35 U.S.C. §112

Claims 1-28

In paragraph 6, Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. For example, in paragraph 6, the Office Action objected that Claims 1, 10, 20, 25, 27, and 28 due to insufficient antecedent basis for "said database systems." Claims 1, 10, 20, 25, 27, and 28 as well as other claims have been amended to consistently use the term "database." Therefore, Applicants believe that this objection has been addressed.

Secondly, in paragraph 6, the Office Action objected to the term "many" in Claim 1. Claim 1 has been amended to recite "one or more of which comprise a

database” instead of “many of which comprise databases.” Therefore, Applicants believe this objection has been addressed.

Thirdly in paragraph 6, the Office Action states, “Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP 2172.01. The omitted elements are: preamble references a system for archiving and restoring data... However, the functionality recited in the body of claim 1 doesn’t appear to produce a tangible result nor does it appear to actually support the preamble.” Claim 1 has been amended to recite “wherein said data is archived on said archival storage device to enable restoration of said data.” Therefore, Applicants believe this objection has been addressed.

Fourthly in paragraph 6, the Office Action states, “As per Claims 9 and 19, the steps recited in the body of the claim do not appear to result in archiving data as recited in the preamble. Therefore, the claims appear inaccurate or incomplete under 35 U.S.C. 112, second paragraph.” Claims 9 and 19 have been amended to recite, “wherein archival of said data on said backup storage device is enabled.” Therefore, Applicants believe this objection has been addressed.

CLAIMS REJECTIONS

35 U.S.C. §101

Claims 1-8

In paragraph 8, the Office Action rejected Claims 1-8 under 35 U.S.C. 101 because the Office Action asserts, “the claimed invention is directed to non-statutory subject matter, specifically directed towards a software, per se.” Further, the Office Action states, “As per claim 1, it is unclear that the claim is whether limited to embodiment, which include hardware. The term ‘databases’ in and of itself is insufficiently broad to encompass just the software that sets for the framework for the data. There’s nothing in the specification indicated it necessarily is referring to the combination of the software and hardware, and both the cell manager and the media agent are reasonably interpreted as software routines, claim 1, therefore, appears to be software, per se, which is not statutory.”

First, specifically concerning the Office Action’s statement that software is not statutory. In the 1970s, the USPTO avoided granting patents on inventions relating to

software. In 1981 the Supreme Court forced the PTO to change its position in the Diamond v. Diehr case. Another landmark case that clarified the patentability of computer software is State Street Bank & Trust v. Signature Financial Group issued by the Federal Circuit. MPEP 2106 provides the PTO's guidelines for determining the patentability of computer software. Clearly, the PTO would not provide guidelines for determining the patentability of computer software if computer software was not statutory subject matter. Further, the Applicant respectfully submits that Claims 1-8 read on a software routine is in and of itself not dispositive. Applicant respectfully submits that Claims 1-8 should be evaluated by their limitations not by what those claims incidentally cover.

Second, anyone of ordinary skill in the art would know that a system as recited by Claim 1 could be implemented using hardware, software, firmware, or a combination thereof. Further, there are numerous examples in the specification of various parts of system embodiments including hardware, software, etc... Therefore, the system Claims 1-8 are not limited to software but read on hardware, software, firmware or a combination thereof. Applicants have amended Claims 1-8 to recite "computer system" to clarify that system embodiments can be hardware, software, firmware or a combination thereof as would be known by anyone of ordinary skill in the art.

In paragraph 8, the Office Action further states with regards to Claim 1, "The claim doesn't appear to produce a useful, concrete and tangible result nor does it appear to actually support the preamble. Therefore, the claim cannot be placed in one of four categories of an invention as required by the MPEP 2105." First, it appears to Applicant that the MPEP 2106 is being referred to instead of 2105. Second, Claim 1 recites, among other things "wherein said data is archived on said archival storage device to enable restoration of said data." One, this supports the preamble. Two, this is a useful, concrete and tangible result. There is a great need in the industry to protect data. The company that is best at protecting data has a significant edge in the market place.


CONCLUSION

In light of the above listed amendments and remarks, reconsideration of the rejected claims is requested. Based on the arguments and amendments presented above, it is respectfully submitted that Claims 1-28 overcome the rejections of record. For reasons discussed herein, Applicant respectfully requests that Claims 1-28 be considered by the Examiner. Therefore, allowance of Claims 1-28 is respectfully solicited.

Should the Examiner have a question regarding the instant amendment and response, the Applicant invites the Examiner to contact the Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,
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